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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,862

11/24/2003

Timothy J. Taylor

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5172

48995

7590

09/26/2007

MARSHALL, GERSTEIN & BORUN LLP (DIAL)

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EXAMINER

OGDEN JR, NECHOLUS

ART UNIT

PAPER NUMBER

1751

MAIL DATE

DELIVERY MODE

09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,862

Applicant(s)

TAYLOR ET AL.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-18-2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-3, 5-6, 9, 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,9 and 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-18-2006 has been entered.

Response to Amendment

Seitz et al (6,861,397) is withdrawn in view of applicant's 1.132 Declaration.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The aforementioned claims state that the hydric solvent further comprises additional solvents, wherein said solvents were not previously suggested in independent claim 17 (dipropylene glycol or benzyl alcohol). Therefore, the claims should recite that the "composition further comprises additional solvents...." to further limit the dependent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 2-3, 5-6, 9, 11-26 are rejected under 35 U.S.C. 103(a) as obvious over Beerse et al (6,294,186).

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Beerse et al disclose an antimicrobial composition that is effective against Rhinoviruses and E-coli bacteria (col. 2, lines 1-10). Moreover, said composition comprises 0.01 to 20% by weight of a benzoic acid analog such as salicylic acid (col. 6, lines 20-33); water as a carrier (col. 9, lines 28-31); alcohol such as dihydric alcohols, isopropanol, ethanol or dipropylene glycol (col. 9, lines 44-55 and example 16-17); and a pH of 2-4 with sodium hydroxide pH adjusting agents (col. 19, lines 24-35). Note, see examples 4, 12, 14-15, 16-18.

Beerse et al is silent with respect to the log reduction of at least 3 for 30 seconds.

It would have been obvious to one of ordinary skill in the art to expect the compositions of Beerse et al to exhibit efficacy against bacteria with a log 3 reduction for 30 seconds because Beerse et al teach compositions that maintain a log 2 reduction against viruses for 30 minutes to an hour and the artisan of ordinary skill would expect the compositions of Beerse et al to exhibit a greater reduction in a shorter interval of time, in the absence of a showing to contrary. Moreover, the compositions of Beerse et al teach the same ingredients as claimed for the purpose of making an antimicrobial composition, wherein the artisan of ordinary skill would reasonably expect similar characteristics.

2. Claims 2-3, 5-6, 9, 11-19, 22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hei et al (2002/0168422).

Hei et al disclose a two solvent antimicrobial composition and method of employing the same, wherein said composition is effective against microorganisms such as bacterial and viruses (0020) on a variety of surfaces (0023-0032) to provide a 5-log

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order reduction in bacterial and viral populations (0045-0049). Hei et al further suggest that said compositions comprise 0.001 to 95% by weight of an antimicrobial solvent; about 5 to 99.9% by weight of a diluting solvent; and 0.001 to 65% by weight of an antimicrobial agent (0064). Specifically, the antimicrobial solvent includes benzyl alcohol; the antimicrobial agent includes a carboxylic acid and the diluting solvent includes water (0068 and 0086). With further respect to the antimicrobial agent, Hei et al specifically prefers salicylic acid as the carboxylic acid (0114) and with further respect to the solvent system, Hei et al teach that said composition may optionally comprise an additional solvent such as dipropylene glycol and ethanol in amounts up to 45% by weight (0144-0147). Hei et al further teach the inclusion of adjunct material such as pH adjusters (0164); buffering agents such as phosphates (0176-0177) and other well known materials to provide a pH of 5 and 3.7 (table II and III).

Hei et al do not specifically suggests each of the claimed limitations with sufficient specificity to anticipate the claims, however, absent a showing to the contrary commensurate in scope with the claimed invention, it would have been obvious to one of ordinary skill in the art to combine the components of Hei to specifically teach the claimed invention because Hei et al teach and require each of the claimed ingredients for the purpose of producing an antimicrobial composition.

Response to Arguments

3. Applicant's arguments filed 6-14-2007 have been fully considered but they are not persuasive.

Applicant argues that Beerse et al teach that the addition of a metal-acid complex is "found to provide a synergistic immediate and residual anti-viral and antibacterial efficacy to surfaces to which such compositions are applied" and therefore suggest that the metal-acid, in addition to the aromatic acid compound, acts as an additional anti-microbial agent.

The examiner contends that applicant's claims are bound by the transitional phrase of "comprising which permits the inclusion of additional components not specified in the claim. Moreover, as stated by applicant", Beerse et al do not require metal-salts in all of the embodiments and specifically suggest that the embodiments free of metal salts are effective in provide residual anti-viral efficacy (col. 47, lines 18-55). Therefore, Beerse et al do not require a metal-salt component as suggested by applicant, and further applicant's claims permit the use of additional ingredients not specified.

Applicant argues that Beerse et al fail to suggest a surfactant having 0 to 0.2%; and 5 to 50% by weight of a hydric solvent.

The examiner respectfully disagrees and directs applicant's attention to column 27, lines 55-60, which teaches less than 10% by weight of surfactants are needed. Moreover, as stated above, examples 13 and 17 do not disclose a surfactant. With respect to the hydric solvent, example 17 states 8% by weight of dipropylene glycol.

Applicant argues that example 21 does not comprise a metal-salt but also does suggest high levels of surfactants.

The examiner contends that a reference does not need to teach each of the components in an example to be indicative of obviousness. The general teaching of Beerse et al states that metal –salt complex is not require to perform as suggested (col. 47, lines 18-55). Moreover, Beerse et al teach several embodiments that do not require surfactants (see examples 4, 12, 14-15, 16-18).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Applicant suggests comparative examples 2 and 3 of his specification for proof of unexpected results.

The examiner contends that criticality cannot be established because applicant has not compared the closes prior art with the claimed invention. Moreover, said comparative examples are not commensurate in scope with the claimed invention or the prior art of record. Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In *re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In *re Burckel*, 592 F.2d 1175, 201 USPQ 67

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(CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In re Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Necholus Ogden
Primary Examiner

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